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7590	04/01/2005		EXAMINER	
Jeanine S. Ray-Yarletts IBM Corporation T81/503 PO Box 12195 Research Triangle Park, NC 27709			BLACKWELL, JAMES H	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/910,083	BRITTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James H Blackwell	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 November 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-32 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 20 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

This Office Action is in response to Amendment received 11/22/04.

### ***Specification***

The disclosure is objected to because of the following informalities: patent numbers need to be filled in blank spaces provided on pp. 25, 46, and 48 of the specification. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Independent claims 1, 27, and 30 of the claimed invention is directed to non-statutory subject matter because the language of these claims and their dependents raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. In particular, claims 1, 27, and 30 and their dependents as claimed, could be performed with pencil and paper especially since transcoding, as defined in the specification, is merely translating or transforming the content of a document or file into a different document or file. These functions can be performed without a computer.

Independent Claim 31 sets forth "a system for improved transcoding" that are not clearly set forth as being implemented on a computer or computer-readable-medium. The scope of the claim amounts to nothing more than manipulation of an abstract idea. At best, the claim would read on a transcoding program per se, which does not constitute statutory subject matter.

Independent Claim 32 is not limited to tangible embodiments. In view of the Applicant's disclosure, specification page 11, lines 12-17, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., disks) and intangible embodiments (e.g., distributed from the memory or storage of one computing device over a network of some type to one or more other computing devices for use by such other devices). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5-6, 7-21, and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich (U.S. Patent No. 5,826,025).

In regard to independent Claim 1 (and similarly independent Claims 27, and 30-32), Gramlich teaches *specifying one or more annotations that indicate one or more conditions for when they are to be inserted into a document* in that a user requests a source document with a web browser either by selecting a hypertext link, or by issuing a document request by entering the desired document's URL in the web browser (Col. 4, lines 44-52). The browser then issues an HTTP document request message 117 specifying the URL of the requested document. Unlike existing browsers, the browser 112 issues the document request message 117 to the Annotation Overlay Proxy (AOP) 114 rather than to a firewall proxy or directly to the web servers (Col. 4, lines 53-57). The web browser 112 also issues an HTTP sources message (116) to the AOP (114). This is a new message that specifies the URLs of the overlay groups containing information to be merged by the AOP 114 with the document requested by the user (Col. 4, lines 61-66). Each annotation overlay 119 has five fields: (1) document URL, (2) source, (3) pattern, (4) action and (5) arg (short for argument), which respectively tell

the AOP 114: (1) the URL of the document to which the annotated pertains; (2) which source contributed the annotation overlay; (3) what specific part (or pattern) of the returned document the overlay pertains to; (4) the action to take with respect to the pattern; and (5) any additional information to associate in the merged document with the pattern. This additional information can include text or graphics to be inserted in the merged document or a designation of a "type" annotation, such as grammar error ("gr"), spelling error ("sp"), "agree", or "disagree" (Col. 5, lines 52-67; Table 3). The pattern (3) is a pattern of words or pixels in the requested document that the AOP 114 must operate on. The pattern syntax consists of a list of words or pixels making up the pattern set off by balanced single quotes. For example, in the illustration above, the pattern the AOP 114 must search for in the document identified by the document URL

<http://info.cern.sh/hypertext/WWW/Daemon/User> is: 'Files can be real or synthesized'.

The remaining fields (4) and (5) tell the AOP 114 what actions to take with regard to occurrences in the corresponding document (Col. 9, lines 19-33). Gramlich also teaches *selectively inserting the specified annotations in a target document based on whether the indicated one or more conditions are satisfied, thereby preparing the target document for enhanced transcoding* in that when creating the merged document 120, the AOP 114 first copies the requested document to the merged document. The AOP 114 then adds the associated annotation overlays 119 to the merged document 120 in an order determined by the precedence of the operation associated with each respective annotation overlay 119. In the preferred embodiment, the operations' precedence order, from highest to lowest, is: insert, replace, delete and program. This

precedence order is inversely related to the degree of disruption caused in the merged document 120 by a particular operation. For example, a delete operation from a source 2 (overlay group 152) overlay might delete the pattern needed for an insert operation from a source 1 (overlay group 150) overlay, but not vice versa. Any other precedence scheme could also be implemented. Of course, even given operator precedence, it is inevitable that sometimes the pattern required by an overlay is not in the merged document. When this is the case, the AOP 114 appends the annotation overlay 119 including that pattern to the merged document and links that overlay to an "unassociated.sub.-- annotation" icon displayed at the beginning of the document. By selecting an unassociated.sub.-- annotation icon, a user may read the corresponding annotation overlay 119 which is displayed by the Web browser 112 (Col. 11, lines 62-67; Col. 12, lines 1-17). Hence, Gramlich teaches the selective insertion of annotations based on conditions. The merged document is then returned to the user at the web browser. From that point, it would have been obvious to one of ordinary skill in the art at the time of invention to save the merged document to a file, making it available to other applications for further processing such as advanced transcoding. It would have also been obvious to one of ordinary skill in the art at the time of invention to assume that the patterns being sought, and the eventual annotation could be anything. If for example, the requested document was an HTML document, which it likely is in the invention of Gramlich, anything that can be found in an HTML document could have been acted upon with Gramlich's invention. The benefit of Gramlich's invention would have been to prepare a requested document for a given user based on a number of conditions.

In regard to dependent Claim 2, Claim 2 reflects the method of enhancing document transcoding as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent Claim 5, Gramlich teaches that *at least one of the specified annotations is specified inline within the target document* in that the annotations are merged with the target document (Col. 2, lines 66-67; Col. 3, lines 1-2).

In regard to dependent Claim 6, Gramlich teaches that at least one of the inserted annotations requests clipping content from a document, and further comprising clipping content from the target document based on the at least one of the inserted annotations in that one of the action fields in the annotation overlays involves deleting the specified pattern or a range of words/images surrounding the specified pattern; the pattern is looked for in the requested document that is to be annotated (Col. 9, lines 45-47).

In regard to dependent Claim 7, Gramlich fails to specifically teach that at least one of the inserted annotations describes changes to one or more form elements in a document, and further comprising changing one or more form elements in the target document based on the at least one of the inserted annotations. However, Gramlich does teach that the action field of the annotation overlays (insert, delete, replace, and Run\_Program) would all affect changes to the requested document based on the pattern sought. It would have been obvious to one of ordinary skill in the art at the time of invention to assume that one of those patterns could have been to match form elements since both the overlays and the requested document are both written in HTML and one of the possible components in such a document could have been an HTML form. Gramlich would offer the benefit of changing anything contained in a typical HTML document including form elements.

In regard to dependent Claim 8, Gramlich teaches that *at least one of the inserted annotations prescribes one or more nodes to be replaced in a document, and further comprising replacing one or more nodes in the target document based on the at least one of the inserted annotations* in that the action field in each of the annotation overlays can contain a Replace attribute that acts to replace the specified pattern or a designated part of the document including the specified pattern with the contents of the arg field (Col. 9, lines 48-51).

In regard to dependent Claim 9, Gramlich fails to specifically teach that *at least one of the inserted annotations specifies one or more (attribute name, attribute value) pairs to be inserted into a document, and further comprising inserting one or more (attribute name, attribute value) pairs in the target document based on the at least one of the inserted annotations.* However, Gramlich does teach that the action field of the annotation can contain an Insert attribute overlays (insert, delete, replace, and Run\_Program) would all affect changes to the requested document based on the pattern sought. It would have been obvious to one of ordinary skill in the art at the time of invention to assume that one of those patterns could have been to insert attribute name/value pairs since both the overlays and the requested document are both written in HTML and one of the possible components in such a document would have been a HTML tag containing attribute name/value pairs (e.g., a hyperlink). Gramlich would offer the benefit of changing anything contained in a typical HTML document including name/value pairs.

In regard to dependent Claim 10, Gramlich fails to specifically teach that *at least one of the inserted annotations specifies fine-grained transcoding preferences to be inserted into a document, and further comprising inserting fine-grained transcoding preferences in the target document based on the at least one of the inserted annotations.* However, Gramlich does teach that the action field of the annotation overlays (insert, delete, replace, and Run\_Program) would all affect changes to the requested document based on the pattern sought. It would have been obvious to one of ordinary skill in the art at the time of invention to assume that one of those actions could have been to insert fine-grained transcoding preferences since the invention of Gramlich is capable of inserting annotations regardless of what those annotations might contain. One of the goals in annotating any document is to enhance it in some way, so that it becomes more useful and informative to the eventual recipient. Inserting preferences to assist in further actions on the document would be just one of many examples of annotations that would enhance the document for the eventual recipient be that a person, or additional coding.

In regard to dependent Claim 11, claim 11 reflect the method of enhancing document transcoding as claimed in claim 10, and is rejected along the same rationale.

In regard to dependent Claims 12-15, Claims 12-15 reflects the method of enhancing document transcoding as stated in Claim 1, and are rejected along the same rationale.

In regard to dependent Claim 16, Gramlich teaches that *the location is expressed using positional information that is based upon target tags in a target* in that a pattern (3) is a pattern of words or pixels in the requested document that the AOP 114 must operate on. The pattern field is necessary, as the document URL in an annotation overlay does not provide *fine location* within a document but merely a pointer to the document as a whole. The pattern syntax consists of a list of words or pixels making up the pattern set off by balanced single quotes (Col. 9, lines 19-27).

In regard to dependent Claim 17, Gramlich does not explicitly teach that *the positional information enables case-insensitive matching of text in the target document*. However, given that the pattern field of Gramlich consists of a pattern of words or pixels in the requested document that the AOP 114 must operate on. The pattern field is necessary, as the document URL in an annotation overlay does not provide fine location within a document but merely a pointer to the document as a whole. The pattern syntax consists of a list of words or pixels making up the pattern set off by balanced single quotes (Col. 9, lines 19-27). It would have been obvious to one of ordinary skill in the art at the time of invention to assume that the pattern defined in a given annotation overlay could have been made to be “case-insensitive” as this would have benefited the matching of items in the target document by ignoring case since different authors might code the HTML in different ways. For example, some web authors like to capitalize HTML tags. By ignoring case, those tags would always be found. Likewise, some authors prefer to capitalize attribute names (e.g., ALT=""').

In regard to dependent Claim 18, Gramlich fails to explicitly teach that *the positional information enables the selectively inserting step to operate with statically generated document content as well as with dynamically generated document content.* However, Gramlich does teach that the requested document is first copied to the merged document (the target) (Col. 11, lines 62-63). If one assumes that the requested document is static, then the initial target document is also static. Once the annotation overlays act on the target document, it becomes a dynamically generated document in that the annotations are dynamically changing the contents of the original static document. Hence, It would have been obvious to one of ordinary skill in the art at the time of invention to conclude that the selectively inserting step would have been working on both static and dynamically generated documents in this case, as claimed.

In regard to dependent Claims 19-20, claims 19-20 reflects the method of enhancing document transcoding as claimed in claim 17, and is rejected along the same rationale.

In regard to dependent Claim 21, Gramlich teaches a *definition of the annotation indicates whether the annotation should be inserted before or after the location* in that for example, in Table 3: 1) <http://info.cern.sh/hypertext/WWW/Daemon/User> (3)(4) `Files can be real or synthesized` [Insert after sentence] (5) Unfortunately, there is no way to tell the difference between synthesized and real files; this makes it extremely difficult to reliably cache HTML documents using the CERN server (Col. 12, lines 51-57). In this example, the “[Insert after sentence]” require that the annotation occur after the location.

In regard to dependent Claim 23, Gramlich fails to explicitly teach that *the at least one specified annotation further specifies one or more rows and/or columns to be clipped from the tables*. However, Gramlich does teach that the action field of the annotation overlays (insert, delete, replace, and Run\_Program) would all affect changes to the requested document based on the pattern sought (Col. 9, lines 35-54). It would have been obvious to one of ordinary skill in the art at the time of invention to assume that one of those changes could have been to delete (clip) one or more columns/rows of a table since the invention of Gramlich includes the possibility of annotation overlays that delete (clip) items from a requested document regardless of what those items are as long as the pattern is matched. The benefit would have been to provide a document for a given user or for further processing by other applications.

In regard to dependent Claims 24-25, Gramlich fails to specifically teach a *definition of a particular one of the specified annotations states at least one (key, value) pair as a condition that indicates when the particular annotation is to be inserted into a document.* However, Gramlich does teach that each of the annotation overlays (which can exist in groups (Col. 6, lines 58-67; Col. 7, lines 1-4)) contain patterns that are designed to match certain portions of the requested document (Col. 9, lines 18-33). The patterns can consist of practically anything. The actions to be taken once a pattern is identified can include an Insert action that inserts the contents of the arg field into the requested document at a specified location relative to the pattern found (Col. 9, lines 35-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to conclude that the invention of Gramlich could have used a key/value pair as a pattern to identify in the requested document, providing the benefit of locating a particular URL and inserting an annotation near it.

In regard to dependent Claim 26, Gramlich fails to explicitly teach that *the location is expressed using Xpath notation.* It is well known that XPath is a language for finding information in an XML document. XPath is used to navigate through elements and attributes in an XML document. Hence, it is a pattern matching language. Gramlich uses patterns in its annotation overlays. It would have been obvious to one of ordinary skill in the art at the time of invention to conclude that one could have used Xpath notation in the invention of Gramlich, just as one could have used any other form of pattern matching syntax. The benefit would have been to better locate patterns in a markup language document such as HTML, SGML, and XML and annotate them.

In regard to dependent Claims 28-29, claims 28-29 reflect the method of enhancing document transcoding as claimed in claim 1 (and similarly claim 27) and is rejected along the same rationale.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich in view of Nagami (U.S. Patent No. 5,548,508).

In regard to dependent Claim 3, Gramlich fails to teach *transcoding the target document using the inserted annotations*. However, Nagami teaches a machine translation engine for carrying out the machine translation operation after accepting the document having the supplementary translation information (Col. 2, lines 12-14). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Gramlich and Nagami as both inventions relate to annotated documents. Adding the teaching of Nagami provides the benefit of further refining the transcoding of the requested document.

Claims 4, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich in view of Anderson et al. (hereinafter, Anderson, U.S. Patent No. 5,581,682).

In regard to dependent Claim 4, Gramlich fails to teach that *at least one of the specified annotations is specified separately from the target document*. However, Anderson teaches that the annotations are overlaid on the final-form document much as one would overlay one transparency slide over another where the topmost sheet

represents an annotation. In this way, it adds to the content of the document without physically being written atop the bottom slide (the original). Using the two-slide metaphor, Thus, Anderson teaches that the annotations are separate from the target document as claimed (Col. 2, lines 24-36). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Gramlich and Anderson as both inventions relate to annotating documents. Anderson's teaching provides the benefit of keeping the original document intact.

In regard to dependent Claim 22, Gramlich fails to explicitly teach that *the at least one specified annotation further specifies one or more exceptions to the clipping of the content*. However, Anderson teaches that in order to apply a reduction overlay, one needs to have proper security and that the security has to match the level assigned to the overlay (Fig. 5, block 8). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Gramlich and Anderson as both inventions relate to annotating documents. Adding the teaching of Anderson further clarifies the annotation process described by Gramlich.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell  
03/18/05



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